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UNITED STATES PATENT AND TRADEMARK OFFICE
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BRIAN P. KINNEAR
HOLLAND & HART
SUITE 3200
555 17TH STREET
DENVER CO 80202

COPY MAILED

MAR 09 2004

OFFICE OF PETITIONS

In re Application of :
Kerns and Bernard : DECISION REFUSING STATUS
Application No. 10/665,909 : UNDER 37 CFR 1.47(a)
Filed: 18 September, 2003 :
Atty Docket No. 35693.830007.US0 :

This is in response to the petition filed under 37 CFR 1.47(a) on 29 January, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 18 September, 2003, without an executed oath or declaration. Accordingly, on 11 December, 2003, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring, *inter alia*, an executed oath or declaration and a surcharge for its late filing.

In response, on 29 January, 2004, petitioners filed a declaration naming Mark Kerns and Noah Bernard as joint inventors, signed by joint inventor Kerns, and the late-filing surcharge.

Petitioners state that joint inventor Bernard cannot be contacted to sign the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2).

In regards to item (1), petitioners have not provided proof that Bernard was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹ While the petition states that a copy of the application, claims, and drawings were sent to joint inventor Bernard's last known address, it is unclear from the petition whether the statement was made by a person with first-hand knowledge that the documents were in fact sent.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

In regards to item (2), the declaration present with the present petition is defective in that it lacks the residence and mailing address of non-signing inventor Bernard. The oath or declaration

¹MPEP 409.03(d).

must identify the mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor.² Petitioners must submit a new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by all of the signing inventors on behalf of themselves and the non-signing inventor.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 2011 South Clark Place
 Customer Window
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

²37 CFR 1.63(c).